

### **REMARKS**

The Office Action dated January 29, 2004 has been received and carefully noted. The period for response having been extended from April 29, 2004 to July 29, 2004 by the attached Petition for Extension of Time, the above amendments to the claims and the following remarks, are submitted as a full and complete response thereto.

Claims 1-28 had previously been cancelled and claim 40 is cancelled herein without prejudice or disclaimer of the subject matter recited therein. Therefore, upon entry of this Response, claims 29-39 and 41-56 will be pending in the present application. Claims 29 and 48 are independent claims. Claims 29-30, 34-35, 41-42, and 48-52 have been made to more particularly point out and distinctly claim the present invention. Support for the amendments made to claims 29-30, 34-35, 41-42, and 48-52 may be found throughout the present application. Hence, no new matter has been added. Claims 29-39 and 41-56 are respectfully submitted for consideration.

#### **Rejection of Claims 29, 31, 34, 40-44, and 48-54 under 35 U.S.C. §102(b):**

Claims 29, 31, 34, 40-44, and 48-54 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,579,535 to Orlen et al. (Orlen '535). The cancellation of claim 40 having rendered the rejection thereof moot, Applicants respectfully submit that claims 29, 31, 34, 41-44, and 48-54 recite subject matter which is neither disclosed nor suggested by Orlen '535.

Claim 29, upon which claims 30-39 and 41-47 depend, recites a method for providing a service to a subscriber in a network. The method includes providing a network related information which is related to the subscriber, generating a service message on the basis of the provided network related information, and transmitting the service message to the subscriber. According to the method, the network related information is provided for a service provider, the service message is a message generated by the service provider, the service message is transmitted to all those subscribers for which the same network related information is provided to the service provider, and the network related information of the subscriber is transmitted in a header of a packet transmitted by the mobile station of the subscriber.

Claim 48, upon which claims 49-56 depend, recites a system for providing a service to a subscriber in a network. The system includes providing means for providing a network related information which is related to the subscriber, and control means for controlling the provision of the network related information in dependence on a predetermined subscriber condition. According to the system, the providing means is arranged to provide the network related information for a service provider connected to the network, and the service provider is arranged to generate a message on the basis of the network information, the message being transmitted to the subscriber. Also according to the system, the service message is transmitted to all those subscribers for which the same network related information is provided to the service provider, and the network

related information of the subscriber is transmitted in a header of a packet transmitted by the mobile station of the subscriber.

As discussed in the present specification, according to certain embodiments of the claimed invention, a subscriber-specific service message based on provided network information of the subscriber can be transmitted by the service provider to any desired mobile station of the cellular network, since the mobile station is not required to generate and transmit a specific information relating to its location, identity, or operating state. Also, since the provision of the individual network information can be controlled in dependence on a predetermined subscriber condition, the service can be restricted to selected ones of the subscribers. It is respectfully submitted that Orlen '535 fails to disclose or suggest the elements of any of the presently pending claims and therefore fails to provide at least these advantages of the claimed invention.

Orlen '535 discloses a personal communication system providing a supplemental information mode. More specifically, Orlen '535 discloses portable radiotelephone handsets and a system information data base for transmission to the telepoint base stations, which are equipped to provide the positional and localized information to requesting radiotelephone handsets. Orlen '535 also discloses that the information is relating or pertaining to the conduct of business. Orlen '535 further discloses that the information is only delivered to the portable radio telephone upon request of the portable radio telephone.

However, Orlen '535 fails to disclose or suggest at least "providing a network related information which is related to said subscriber", as recited in claims 29-39 and 41-47 of the present application. Orlen '535 also fails to disclose or suggest at least the "providing means for providing a network related information which is related to said subscriber" recited in claims 48-56. In addition, Orlen '535 also fails to disclose or suggest at least that "said service message is transmitted to all those subscribers for which the same network related information is provided to the service provider; and [that] the network related information of the subscriber is transmitted in a header of a packet transmitted by the mobile station of the subscriber", as recited in claims 29-39 and 41-56.

One of skill in the art will appreciate that the methods and systems recited in claims 29, 32, 34, 41-44, and 48-54 of the present application enable a point-to-multipoint service message distribution. One of skill in the art will also appreciate that the methods and systems recited in these claims provide this distribution without necessitating any user interaction. In contrast, Orlen '535 merely discloses point-to-point service message delivery upon an express request of a respective user. At least for these reasons, Applicants respectfully submit that claims 29, 32, 34, 41-44, and 48-54 are patentable over Orlen '535.

In addition, on page 2 of the Office Action, it was alleged that Orlen '535 discloses the step of "providing a network (base station) information related to said subscriber (i.e. the radio telephone sends a data mode request)". In view of this allegation, it appears as though "providing a network information related to said

subscriber”, which was previously recited in claims 29-56, was interpreted as “providing a network with information related to said subscriber”. However, Applicants respectfully submit that this was a misinterpretation of the claimed invention.

Claims 29 and 48 recite “providing a network related information which is related to said subscriber”. Applicants also respectfully submit that, at least in view of claims 30 and 49, which recite that the network related information relates to at least one of an identity, a location, an address, and an operating state of a mobile station of the subscriber in a cellular network, one of skill in the art understands the correct interpretation of the subject matter recited in the claims of the present application. Applicants further submit that this subject matter is neither disclosed nor suggested in Orlen ‘535.

Also on page 2 of the Office Action, it was alleged that Orlen ‘535 discloses the step of “generating a service message (directory or menu information) on the basis of said provided network (base station)”. However, claims 29-39 and 41-47 actually recite “generating a service message on the basis of said provided *network related information* (emphasis added)”. In other words, service messages according to the claimed invention are generated on the basis of network related information, not on the basis of the provided network.

At least for the reasons discussed above, Applicants respectfully submit that claims 29, 31, 34, 41-44, and 48-54 are patentable over Orlen ‘535. Therefore,

reconsideration and withdrawal of the rejection of claims 29, 31, 34, 41-44, and 48-54 under 35 U.S.C. §102(b) over Orlen '535 is respectfully requested.

Rejection of Claim 32 under 35 U.S.C. §103(a):

Claim 32 was rejected under 35 U.S.C. §103(a) over Orlen '535 in view of U.S. Patent No. 5,905,777 to Foladare et al. (Foladare '777). In the Office Action, it was acknowledged that Orlen '535 fails to disclose a header (summary) message of an unread mail stored in a mail server. However, it was alleged in the Office Action that Foladare '777 could be combined with Orlen '535 to yield the claimed invention. However, Applicants respectfully submit that claim 32 recites subject matter which is neither disclosed nor suggested in either Orlen '535 or Foladare '777, taken either individually or in combination.

Claim 32 is dependent upon claim 29 and therefore recites “providing a network related information which is related to said subscriber” and that “said service message is transmitted to all those subscribers for which the same network related information is provided to the service provider; and [that] the network related information of the subscriber is transmitted in a header of a packet transmitted by the mobile station of the subscriber”, as recited in claim 29. In addition, claim 32 recites that the service message is a header of an unread mail stored in a mail server.

As discussed above, Orlen '535 fails to disclose or suggest at least “providing a network related information which is related to said subscriber”, as recited in claim 32 of

the present application. As also discussed above, Orlen '535 also fails to disclose or suggest at least that "said service message is transmitted to all those subscribers for which the same network related information is provided to the service provider; and [that] the network related information of the subscriber is transmitted in a header of a packet transmitted by the mobile station of the subscriber", as also recited in claim 32.

Foladare '777 discloses an e-mail paging system. Foladare '777 also discloses that useful e-mail messages can be identified, separated from the junk mail, and forwarded as directed by the recipient.

However, Foladare '777 fails to address or eliminate the shortcomings of Orlen '535. Therefore, Applicants respectfully submit that claim 32 is patentable over Orlen '535 and Foladare '777, taken either individually or in combination. In view of the above, reconsideration and withdrawal of the rejection of claim 32 under 35 U.S.C. §103(a) over Orlen '535 in view of Foladare '777 is respectfully requested.

*Rejection of Claims 33, 35-38, and 45 under 35 U.S.C. §103(a):*

Claims 33, 35-38, and 45 were rejected under 35 U.S.C. §103(a) over Orlen '535 in view of U.S. Patent No. 5,555,446 to Jasinski (Jasinski '446). In the Office Action, it was acknowledged that Orlen '535 fails to disclose a stock price change. However, it was alleged in the Office Action that Jasinski '446 could be combined with Orlen '535 to yield the claimed invention. Applicants respectfully submit that claims 33, 35-38, and 45 recite subject matter which is neither disclosed nor suggested in Orlen '535 or Jasinski '446, taken either individually or in combination.

Claims 33, 35-38, and 45 each depend upon claim 29 and therefore inherently recite “providing a network related information which is related to said subscriber” and that “said service message is transmitted to all those subscribers for which the same network related information is provided to the service provider; and [that] the network related information of the subscriber is transmitted in a header of a packet transmitted by the mobile station of the subscriber”, as recited in claim 29.

As discussed above, Orlen ‘535 fails to disclose or suggest at least “providing a network related information which is related to said subscriber”, as recited in claims 33, 35-38, and 45 of the present application. As also discussed above, Orlen ‘535 also fails to disclose or suggest at least that “said service message is transmitted to all those subscribers for which the same network related information is provided to the service provider; and [that] the network related information of the subscriber is transmitted in a header of a packet transmitted by the mobile station of the subscriber”, as recited in claims 33, 35-38, and 45.

Jasinski ‘446 discloses a selective call receiver capable of requesting information from a communication system and a method therefore. Jasinski ‘446 also discloses that the communication system has a base station having memory for storing information within a plurality of information files relating to a plurality of information services.

However, Jasinski ‘446 fails to address or eliminate the shortcomings of Orlen ‘535. Therefore, Applicants respectfully submit that claims 33, 35-38, and 45 are patentable over Orlen ‘535 and Jasinski ‘446, taken either individually or in combination.



At least in view of the above, reconsideration and withdrawal of the rejection of claims 33, 35-38, and 45 under 35 U.S.C. §103(a) over Orlen '535 in view of Jasinski '446 is respectfully requested.

Rejection of Claim 39 under 35 U.S.C. §103(a):

Claim 39 was rejected under 35 U.S.C. §103(a) over Orlen '535 in view of Jasinski '446 and in further view of U.S. Patent No. 6,141,558 to Chen (Chen '558). In the Office Action, it was acknowledged that the combination of Orlen '535 and Jasinski '446 fails to disclose a network operator that receives the request including a service provider address, retrieves location coordinates of the subscriber and transmits the location to the service provider using the received address. However, it is alleged in the Office Action that Chen '558 may be combined with Orlen '535 and Jasinski '446 to yield the claimed invention. Applicants respectfully submit that claim 39 recites subject matter which is neither disclosed nor suggested in Orlen '535, Jasinski '446, and Chen '558, taken either individually or in combination.

Claim 39 is dependent upon claim 29 and thereby inherently recites "providing a network related information which is related to said subscriber" and that "said service message is transmitted to all those subscribers for which the same network related information is provided to the service provider; and [that] the network related information of the subscriber is transmitted in a header of a packet transmitted by the mobile station of the subscriber", as recited in claim 29. Claim 39 also recites that a network operator

receives the request including a service provider address, retrieves location coordinates of the subscriber on the basis of a cell identification, and transmits the location coordinates to the service provider using the received address.

As discussed above, Orlen '535 and Jasinski '446, taken either individually or in combination, fail to disclose or suggest at least "providing a network related information which is related to said subscriber", as recited in claim 39 of the present application. As also discussed above, Orlen '535 and Jasinski '446 each also fail to disclose or suggest at least that "said service message is transmitted to all those subscribers for which the same network related information is provided to the service provider; and [that] the network related information of the subscriber is transmitted in a header of a packet transmitted by the mobile station of the subscriber", as recited in claim 39.

Chen '558 discloses a method and an apparatus for locating a subscriber unit in a communication system. Chen '558 also discloses that when a distressed subscriber is at a location in the communication coverage area, and the distressed subscriber calls an emergency service such as 911 for assistance on a mobile subscriber communication unit, an emergency communications center receives a Mobile Identification Number or subscriber ID of the mobile subscriber communication unit and a base station ID of the BTS.

However, Chen '558 fails to address or eliminate the shortcomings of Orlen '535 and Jasinski '446. Therefore, Applicants respectfully submit that claim 39 is patentable over Orlen '535, Jasinski '446, and Chen '558, taken either individually or in

combination. At least in view of the above, reconsideration and withdrawal of the rejection of claim 39 under 35 U.S.C. §103(a) over Orlen '535 in view of Jasinski '446 and in further view of Chen '558 is respectfully requested.

Rejection of Claims 46-47 under 35 U.S.C. §103(a):

Claims 46-47 were rejected under 35 U.S.C. §103(a) over Orlen '535 in view of Jasinski '446 and in further view of WO 98/21913 to Bhatia (Bhatia '913). In the Office Action, it was acknowledged that the combination of Orlen '535 and Jasinski '446 fails to disclose an activation of a predetermined supplementary service and that the subscriber is located in this home area. However, it was alleged in the Office Action that Bhatia '913 may be combined with Orlen '535 and Jasinski '446 to yield the claimed invention. Applicants respectfully submit that claims 46-47 recite subject matter which is neither disclosed nor suggested in Orlen '535, Jasinski '446, and Bhatia '913, taken either individually or in combination.

Claims 46 and 47 each depend upon claim 29 and thereby inherently recite “providing a network related information which is related to said subscriber” and that “said service message is transmitted to all those subscribers for which the same network related information is provided to the service provider; and [that] the network related information of the subscriber is transmitted in a header of a packet transmitted by the mobile station of the subscriber”, as recited in claim 29.

As discussed above, Orlen '535 and Jasinski '446 each fail to disclose or suggest at least "providing a network related information which is related to said subscriber", as recited in claims 46-47 of the present application. As also discussed above, Orlen '535 and Jasinski '446 each also fail to disclose or suggest at least that "said service message is transmitted to all those subscribers for which the same network related information is provided to the service provider; and [that] the network related information of the subscriber is transmitted in a header of a packet transmitted by the mobile station of the subscriber", as recited in claims 46-47.

Bhatia '913 discloses an address retrieval system. More specifically, Bhatia '913 discloses a method and apparatus for enabling a user to request location information from a mobile station telephone unit.

However, Bhatia '913 fails to address or eliminate any of the shortcomings of Orlen '535 and Jasinski '446. Therefore, Applicants respectfully submit that claims 46 and 47 are patentable over Orlen '535, Jasinski '446, and Bhatia '913, taken either individually or in combination. At least in view of the above, reconsideration and withdrawal of the rejection of claims 46-47 under 35 U.S.C. §103(a) over Orlen '535 in view of Jasinski '446 and in further view of Bhatia '913 is respectfully requested.

Rejection of Claims 55-56 under 35 U.S.C. §103(a):

Claims 55-56 were rejected under 35 U.S.C. §103(a) over Orlen '535 in view of Bhatia '913. In the Office Action, it was acknowledged that Orlen '535 fails to disclose

an activation of a predetermined supplementary service and that the subscriber is located in his home area. However, it was alleged in the Office Action that Bhatia '913 may be combined with Orlen '535 to yield the claimed invention. Applicants respectfully submit that claims 55-56 recite subject matter which is neither disclosed nor suggested in Orlen '535 and Bhatia '913, taken either individually or in combination.

Claims 55-56 each depend upon claim 48 and thereby inherently recite "providing means for providing a network related information which is related to said subscriber" and that "said service message is transmitted to all those subscribers for which the same network related information is provided to the service provider; and [that] the network related information of the subscriber is transmitted in a header of a packet transmitted by the mobile station of the subscriber", as recited in claim 29.

As discussed above, Orlen '535 fails to disclose or suggest at least the "providing means for providing a network related information which is related to said subscriber" recited in claims 55-56. In addition, Orlen '535 also fails to disclose or suggest at least that "said service message is transmitted to all those subscribers for which the same network related information is provided to the service provider; and [that] the network related information of the subscriber is transmitted in a header of a packet transmitted by the mobile station of the subscriber", as recited in claims 55-56.

As discussed previously, Bhatia '913 fails to address or eliminate any of the shortcomings of Orlen '535. Therefore, Applicants respectfully submit that claims 55-56 are patentable over Orlen '535 and Bhatia '913, taken either individually or in

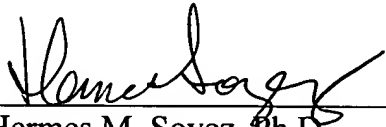
combination. At least in view of the above, reconsideration and withdrawal of the rejection of claims 55-56 under 35 U.S.C. §103(a) over Orlen '535 in view of Bhatia '913 is respectfully requested.

Applicants respectfully submit that all of the issues raised in the Office Action have been addressed and that all of the rejections included in the Office Action have been overcome. Hence, Applicants respectfully further submit that claims 29-39 and 41-56 of the present application contain allowable subject matter. Therefore, it is respectfully requested that all claims pending in the present application be allowed, and that this application be passed to issue.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, the Applicants' undersigned representative at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,

  
Hermes M. Soyez, Ph.D.  
Registration No. 45,852

**Customer No. 32294**  
SQUIRE, SANDERS & DEMPSEY LLP  
14<sup>TH</sup> Floor  
8000 Towers Crescent Drive  
Tysons Corner, Virginia 22182-2700  
Telephone: 703-720-7800  
Fax: 703-720-7802

HMS:jd/mm

Enclosure: Petition for Extension of Time